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EXAMINER

RIES, LAURIE ANNE

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/995,224 | Applicant(s) KLEIN ET AL. | |
| | Examiner Laurie Ries | Art Unit 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Request for Continued Examination, filed 18 May 2006, to the original application filed 26 November 2001.
2. Claims 1-23 remain rejected under 35 U.S.C. 103(a).
3. Claims 1-23 are pending. Claims 1, 12, and 21 are independent claims.

Examiner's Comments

4. It is noted that the Amendment filed 18 April 2006 requesting reconsideration of the declarations and evidence filed on 1 July 2005 under 37 C.F.R. 1.131 was entered and the arguments were addressed in the Advisory Action filed 2 May 2006. Applicant's Request for Continued Examination, filed 18 May 2006, contained no new amendments or arguments above and beyond those addressed in the above mentioned Advisory Action, therefore, this action as been made final. For convenience, the response to arguments included in the Advisory Action filed 2 May 2006 have been repeated below.

Response to Arguments

5. Applicant's arguments filed 18 May 2006 have been fully considered but they are not persuasive.

From MPEP § 715.07 (III):

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR § 1.131). As discussed above, 37 CFR § 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show: (A) reduction to practice of the invention prior to the effective date of the reference; or (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

From MPEP § 2138.04[R-1]:

Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482

(CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.)

In the case of the declarations and related attachments filed 1 July 2005, since the Applicant is alleging actual reduction to practice before the date of the applied references, the date of conception is not an issue. However, the Applicant has failed his burden to establish that the ENTIRE claimed invention, including all of the claimed features and limitations, was included as part of the PowerPoint presentation as disclosed by Attachment B of the declaration.

Additionally, Applicant has not addressed the issue of the declaration by Hittle, which was deemed improper as noted in the Office action, filed 15 February 2006. for omitting signatures of all of the claimed subject matter (See Final Office action filed 15 February 2006, paragraph #4, last 2 lines).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 7, 10, 10-12 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1).

As per independent claims 1 and 12, Goodisman discloses a system and method for providing associated links in content viewable by a computing browser-type application capable of receiving and displaying content including receiving online content by a computing application from a cooperating content server over a communications network (See Goodisman, Page 3, paragraphs 0032-00330, a recognizer, or pattern matcher, that cooperates with a linkify engine or helper object to compare the content with a predefined list of key-phrases and/or syntactic rules for recognizing key-phrase candidates. (See Goodisman, Page 6, paragraph 0053).

Goodisman does not disclose expressly a helper object that does not cooperate with any other content viewing application.. Subramanian discloses a Match Maker, equivalent to the helper object of the Instant Application, whose function is to parse the content of the current page, group attributes to form structured objects, communicate

with the Rules Registry, and produce a set of contextually relevant advertisements (See Subramanian, Page 7, paragraph 0102, and Page 10, paragraph 0133).

Goodisman and Subramanian are analogous art because they are from the same field of endeavor of linking data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the Match Maker of Subramanian with the system and method for providing associated links of Goodisman. The motivation for doing so would have been to affiliate links that are automatically determined to be relevant to the customer's current interest on the Internet (See Subramanian, Page 1, paragraph 0002).

Therefore, it would have been obvious to combine Subramanian with Goodisman for the benefit of affiliating links that are automatically determined to be relevant to the customer's current interest on the Internet to obtain the invention as specified in claims 1 and 12.

As per dependent claim 2, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses at least one action handler, or targeting feature, to execute at least one pre-defined action related to the associated links. (See Goodisman, Page 6, paragraph 0053, and Page 7, paragraph 0056).

As per dependent claim 3, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Subramanian also discloses automatically updating the predefined list of key-phrases and/or syntactic rules (See Subramanian, Page 5, paragraph 0074). Goodisman and Subramanian are analogous art because

they are from the same field of endeavor of linking data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include automatic updating of the database of Subramanian with the system for providing associated links of Goodisman. The motivation for doing so would have been to access the latest data whenever the browser is used (See Subramanian, Page 5, paragraph 0074).

Therefore, it would have been obvious to combine Subramanian with Goodisman for the benefit of accessing the latest data whenever the browser is used to obtain the invention as specified in claim 3.

As per dependent claim 4, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses that the computing application includes a content browser computing application. (See Goodisman, Page 6, paragraph 0053).

As per dependent claim 7, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses that the associated links offer features including additional associated links, which is included in the list of possible features set forth in claim 7. (See Goodisman, Pages 3-4, paragraph 0037).

As per dependent claim 10, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses that the computing browser-type application resides on a client computer of a networked computer environment. (See Goodisman, Figure 3, elements 42 and 48).

As per dependent claim 11, Goodisman and Subramanian disclose the limitations of claim 10 as described above. Goodisman also discloses that the received content is received from at least one computer server of the networked computer environment. (See Goodisman, Figure 3, element 44).

As per dependent claim 15, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses executing the match true associated links upon interaction from participating users, the interaction being realized through at least one input from a user interface with the match true associated links. (See Goodisman, Page 3, paragraphs 0035-0036, Page 4, paragraph 0038, and Page 7, paragraph 0059).

As per dependent claim 16, Goodisman and Subramanian disclose the limitations of claim 15 as described above. Goodisman also discloses aggregating content associated with the executed associated link, the aggregated content including any of a group including additional associated links, additional relevant content related to the executed content, execution commands for search operations, and execution commands to launch cooperating applications (See Goodisman, Page 3-4, paragraph 0037), and generating an interactive display pane, which is populated with the aggregated content. (See Goodisman, Page 3-4, paragraph 0037).

As per dependent claim 17, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses separating the received online content into phrases and communicating the phrases to the recognizer, or pattern matcher. (See Goodisman, Page 6, paragraph 0053).

As per dependent claim 18, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses processing the phrases to identify any words that are contained in the predefine list of associated links. (See Goodisman, Page 6, paragraph 0053).

As per dependent claim 19, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses highlighting the match true associated links such that they appear having a different color and/or format than surrounding non-associated link content. (See Goodisman, Page 6, paragraph 0053).

As per dependent claim 20, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses a computer readable medium having computer executable instructions for performing the steps in claim 12. (See Goodisman, Page 7, paragraphs 0060 and 0062).

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1), as applied to claim 1 above, and further in view of Smith (U.S. Patent 6,222,537 B1).

As per dependent claims 5 and 6, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman and Subramanian do not disclose expressly the inclusion of a first and second listener including a set of instructions to monitor and be responsive to interaction with the computing application.

Smith discloses the use of event listener objects, which include a set of instructions to monitor and interact with a computing application. (See Smith, Column 8, lines 23-32). Goodisman, Subramanian and Smith are analogous art because they are from the same field of endeavor of accessing information online. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the event listener objects of Smith with the method and system of providing associated links of Goodisman and Subramanian. The motivation for doing so would have been to be aware of events triggered by user interaction. (See Smith, Column 8, lines 28-32). Therefore, it would have been obvious to combine Smith with Goodisman and Subramanian for the benefit of tracking user interaction to obtain the invention as specified in claims 5 and 6.

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1), as applied to claim 7 above, and further in view of Horowitz (U.S. Patent 6,122,647).

As per dependent claims 8 and 9, Goodisman and Subramanian disclose the limitations of claim 7 as described above. Goodisman and Subramanian do not disclose expressly that the additional associated links are related to an underlying associated link. Horowitz discloses additional associated links that are related to an underlying associated link. (See Horowitz, Figure 5). Goodisman, Subramanian and Horowitz are analogous art because they are from the same field of endeavor of

dynamically generating contextual links. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the additional associated links related to an underlying associated link of Horowitz with the additional associated links of Goodisman and Subramanian. The motivation for doing so would have been to generate new links from the target document that may be available or relevant. (See Horowitz, Column 2, lines 23-29). Therefore, it would have been obvious to combine Horowitz with Goodisman and Subramanian for the benefit of providing additional relevant links to obtain the invention as specified in claims 8 and 9.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1), as applied to claim 12 above, and further in view of Kippenhan (U.S. Publication 2002/0010769 A1).

As per dependent claim 13, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses displaying the generated processed content to participating users through a cooperating display device. (See Goodisman, Page 6, paragraph 0053, Figure 3, element 42, and Page 5, paragraph 0050). Goodisman and Subramanian do not disclose expressly monitoring the activity of the participating users with the match true associated links of generated processed content to offer content associated with the associated links. Kippenhan discloses monitoring user activity on a web browser. (See Kippenhan, Page 3, paragraph 0032). Goodisman, Subramanian and Kippenhan are analogous art because

they are from the same field of endeavor of accessing information online. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the monitoring of user activity on the browser of Kippenhan with the method of providing associated links of Goodisman and Subramanian. The motivation for doing so would have been to identify and provide additional information about a given subject of interest to a user. (See Kippenhan, Page 1, paragraph 0010). Therefore, it would have been obvious to combine Kippenhan with Goodisman and Subramanian for the benefit of identifying and providing the user with additional information of interest to obtain the invention as specified in claim 13.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1) and Kippenhan (U.S. Publication 2002/0010769 A1), as applied to claim 13 above, and further in view of Smith (U.S. Patent 6,222,537 B1).

As per dependent claim 14, Goodisman, Subramanian and Kippenhan disclose the limitations of claim 13 as described above. Goodisman, Subramanian and Kippenhan do not disclose expressly the inclusion of a first and second listener including a set of instructions to monitor and be responsive to interaction with the computing application. Smith discloses the use of event listener objects, which include a set of instructions to monitor and interact with a computing application. (See Smith, Column 8, lines 23-32). Goodisman, Subramanian, Kippenhan and Smith are analogous art because they are from the same field of endeavor of accessing

information online. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the event listener objects of Smith with the method and system of providing associated links of Goodisman, Subramanian and Kippenhan. The motivation for doing so would have been to be aware of events triggered by user interaction. (See Smith, Column 8, lines 28-32). Therefore, it would have been obvious to combine Smith with Goodisman, Subramanian and Kippenhan for the benefit of tracking user interaction to obtain the invention as specified in claim 14.

11. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1) and Baird (U.S. Publication 2003/0080986 A1).

As per independent claim 21, Goodisman discloses a system and method for providing associated links in content viewable by a computing browser-type application capable of receiving and displaying content including receiving online content by a computing application from a cooperating content server over a communications network (See Goodisman, Page 3, paragraphs 0032-00330, a recognizer, or pattern matcher, that cooperates with a linkify engine or helper object to compare the content with a predefined list of key-phrases and/or syntactic rules for recognizing key-phrase candidates (See Goodisman, Page 6, paragraph 0053), and an update engine on a computing application incorporating associated links in online content (See Goodisman, Claim 34).

Goodisman does not disclose expressly a helper object that does not cooperate with any other content viewing application. Subramanian discloses a Match Maker, equivalent to the helper object of the Instant Application, whose function is to parse the content of the current page, group attributes to form structured objects, communicate with the Rules Registry, and produce a set of contextually relevant advertisements (See Subramanian, Page 7, paragraph 0102, and Page 10, paragraph 0133).

Goodisman also does not disclose communicating with an update server to obtain data indicative of an updated associated link list. Baird discloses updating a list of links upon the execution of a preconfigured event. (See Baird, Page 5, paragraph 0048).

Goodisman, Subramanian and Baird are analogous art because they are from the same field of endeavor of linking data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the Match Maker of Subramanian and the update engine of Baird with the system and method for providing associated links of Goodisman. The motivation for doing so would have been to affiliate links that are automatically determined to be relevant to the customer's current interest on the Internet (See Subramanian, Page 1, paragraph 0002) and to remove links which have become outdated or are no longer available. (See Baird, Page 2, paragraph 0021). Therefore, it would have been obvious to combine Subramanian with Goodisman for the benefit of affiliating links that are automatically determined to be relevant to the customer's current

interest on the Internet and to remove links which have become outdated or are no longer available to obtain the invention as specified in claim 21.

As per dependent claim 22, Goodisman, Subramanian and Baird disclose the limitations of claim 21 as described above. Goodisman also discloses modifying the existing predefined associated link lists to include data on the obtained associated link lists (See Goodisman, Page 6, paragraph 0053).

As per dependent claim 23, Goodisman, Subramanian and Baird disclose the limitations of claim 21 as described above. Goodisman also discloses a computer readable medium having computer readable instructions for performing the steps recited in claim 21. (See Goodisman, Page 7, paragraphs 0060 and 0062).

Conclusion

12. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William F. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER